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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,483	11/10/2005	Yusuke Suzuki	S1459.70092US00	3894
23628 7590 07/24/2009 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206			EXAMINER HENRY, CALEB E	
			ART UNIT 2894	PAPER NUMBER
			MAIL DATE 07/24/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,483	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> CALEB HENRY	<b>Art Unit</b> 2894	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/08/2009 has been entered.

### ***Response to Amendment***

2. The amendments filed on 06/09/2009 have been entered.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (5432023).

Regarding claim 1, Yamada teaches an electrode (col. 29, lines 54-67; col. 30, lines 1-2) comprising a carbon (col. 29, lines 54-67; col. 30, lines 1-2) carrying a metal and a binder (col. 29, lines 54-67; col. 30, lines 1-2), the carbon having a specific surface area equal to or larger than 100 m<sup>2</sup>/g (col. 34, lines 8-13).

Regarding claim 2, Yamada teaches an electrode according to claim 1, which is formed on an electrically conductive substrate (col. 47, lines 34-40).

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Regarding claim 3, Yamada teaches an electrode according to claim 2 wherein the electrically conductive substrate is made of glass, a polymer film or a metal (col. 47, lines 34-40).

Regarding claim 4, Yamada teaches an electrode according to claim 1 wherein the carbon is needle-like carbon, fullerene, carbon nanotube or electrically conductive carbon black (col. 34, lines 8-13)

Regarding claim 5, Yamada teaches an electrode according to claim 1 wherein the metal is at least one kind of metal selected from the group consisting of Pt, Ru, Co, Ti, Ni, Al and Au (col. 29, lines 54-67; col. 30, lines 1-2).

Regarding claim 8, Yamada teaches an electrode according to claim 1 wherein the amount of the metal carried by the carbon is equal to or more than 5 weight percent of the carbon (col. 34, lines 8-14).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada.

In regard to Claim 7 Yamada differs from the claimed invention by not showing the specific surface area of the carbon is equal to or larger than 300 m<sup>2</sup>/g. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the specific surface area of the carbon is equal to or larger than 300 m<sup>2</sup>/g,

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since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 18, Yamada teaches an electrode (col. 29, lines 54-67; col. 30, lines 1-2) comprising a carbon (col. 29, lines 54-67; col. 30, lines 1-2) carrying both a metal and a binder (col. 29, lines 54-67; col. 30, lines 1-2).

While Yamada teaches the amount of metal in the electrode to be around 20% (col. 34, lines 8-14), Yamada does not teach an amount of metal in the electrode ranging between 5 wt % and 15 wt % relative to the carbon.

In regard to Claim 18 Yamada differs from the claimed invention by not showing an amount of metal in the electrode ranging between 5 wt % and 15 wt % relative to the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the an amount of metal in the electrode ranging between 5 wt % and 15 wt % relative to the carbon, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to Claim 19 Yamada differs from the claimed invention by not showing the binder in the electrode comprises more than 5 wt % of the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the binder in the electrode comprises more than 5 wt % of the carbon, since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

6. Claim 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, in further view of Ishibashi (JP 2003021410).

Regarding claim 16, Yamada teaches an electrode comprising a carbon carrying a metal and a binder.

However, Yamada does not teach the electrode is disposed immediately adjacent to an electrolytic layer.

Ishibashi teaches an electrode (fig. 1, page 14, 4) disposed immediately adjacent to an electrolytic layer (fig. 1, page 14, 5).

One with ordinary skill in the art would know that the electrolytic layer acting as an electrochemical contact. Also, both teachings are related to the same field of endeavor i.e. fabrication of solar cells.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Ishibashi to the teachings of Yamada due to aforementioned reasons.

Regarding claim 20, Yamada/Ishibashi teaches an electrolytic layer (Ishibashi, fig. 1, page 14, 5) disposed adjacent to the electrode (Ishibashi, fig. 1, page 14, 4) and a semiconductor layer (Ishibashi, fig. 1, page 14, 2) disposed adjacent to the electrolytic layer.

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In regard to Claim 20 Yamada/Ishibashi differs from the claimed invention by not showing the electrolytic layer having a thickness of between about 1 micron and 100 microns. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the electrolytic layer having a thickness of between about 1 micron and 100 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, in view of Yamakawa (US 6656663 B2).

Regarding claim 17, Yamada teaches an electrode comprising a carbon carrying a metal and a binder.

However, Yamada does not teach the binder is insoluble to electrolytes.

Yamakawa teaches the binder is insoluble to electrolytes (Yamakawa, col. 7, lines 62-67).

One with common knowledge in the art would know by having a binder with such properties, this prevents the diffusion of electrolytes, from the electrolytic layer.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Yamakawa to the teachings of Yamada due to aforementioned reasons.

***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Response to arguments on newly added limitations are responded to in above rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Murofushi (7157788 B2) - electrode adjacent to electrolytic layer

Yamada (5800631) – has carbon, metal, binder

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CALEB HENRY whose telephone number is (571)270-5370. The examiner can normally be reached on Monday-Thursday, 7:30 AM- 5:30 PM, ALT. Fridays, Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly D. Nguyen can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art  
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/CALEB HENRY/  
Examiner, Art Unit 2894